

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,155	04/24/2001	Shogo Hyakutake	202319US2X	3275

22850 7590 08/04/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

LIN, WEN TAI

ART UNIT PAPER NUMBER

2154

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/840,155

Applicant(s)

HYAKUTAKE ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-28 and 33-41 is/are rejected.
- 7) ☒ Claim(s) 10-13 and 29-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 9
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/10/02, 4/24/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-41 are presented for examination.
2. Claims 16-17 are objected to because of the following informalities:  
  
As to claim 16, line 4 and claim 17, line 2, the word "to" appears to be a typo of "from".

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 14-17, 19-24, 33-36, 38 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al.[U.S. PGPub 20040024876].

5. As to claim 1, Ito teaches the invention as claimed including: a method of storing document information in an application service provider (ASP) [e.g., an image storage server] which is connected to a user terminal through a network [Fig.1; paragraphs 18 and 35], comprising the steps of:

inputting said document information into said user terminal [paragraphs 42 – 43, 47 and 50-51; e.g., registration information, various control settings, and the detected images are inputted from either a user terminal or the image sensors, and then transmitted to the image storage server];

inputting a previously created e-mail address into said user terminal, said e-mail address being confirmed by said ASP and corresponding to a storage location in said ASP; and sending said document information to said e-mail address via said network [paragraph 62; i.e., when using email as a means for transmitting the image/data, the e-mail address must have been confirmed by the image storage server, otherwise the information would not be directed to the correct location].

6. As to claims 2-5, Ito further teaches that said step of inputting the document information comprises manually inputting said document information into said user terminal [e.g., the registration information is entered manually to a terminal paragraph 50-51, wherein the original registration form is downloaded from the web (i.e., “automatically inputted into the user terminal”) and stored in a storage space (e.g., a local cache), with the various blank fields entered manually afterwards].

7. As to claims 14-15, Ito teaches that the method further comprising sending said document information to a user contact device, wherein said step of sending said document information to said e-mail address comprises sending said document information to said e-mail address concurrently with sending said document information to said user contact device, wherein said step of sending said document information to a user contact device comprises sending said document information to said user contact device via one of a public phone line and the Internet [paragraphs 18 and 43].

8. As to claims 16-17, Ito teaches that the method further comprising receiving said document information from a user contact device and automatically sending said document information to said e-mail address concurrently with receiving said document information from said user contact device via the Internet [paragraphs 18 and 47-48; e.g., when a user changes the image condition, the settings and the images are concurrently sent to the image storage server].

9. As to claims 19-24, 33-36, 38 and 40-41, since the features of these claims can also be found in claims 1-5 and 14-17, they are rejected for the same reasons set forth in the rejection of claims 1-5 and 14-17 above.

***Claim Rejections - 35 USC § 103***

Art Unit: 2154

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-9, 18, 25-28, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (hereafter "Ito") [U.S. PGPub 20040024876], as applied to claims 1-5, 14-17, 19-24, 33-36, 38 and 40-41 above, further in view of official Notice.

12. As to claims 6-8, Ito teaches the step of sending the image information via an email, wherein, by default, the e-mail address must have been previously acquired from the image storage server.

Ito does not specifically teach storing the email address in a memory of said user terminal and associating said stored e-mail address with a quick send key on a keypad of said user terminal and inputting said e-mail address in response to a selection of said quick send key.

However, official Notice is taken that it is well known in the art that when sending email via an Internet Service Provider (ISP), the subscriber's PC is normally provided with a email agent for storing email address book in a local memory and a selected email address can be quickly entered into the "send to" or "copy to" fields by activating a quick send key (which may also be a predefined key on the alphanumeric keypad).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such a quick send key for sending official Notice's email because the method is known to be convenient and could also prevent typos.

13. As to claim 9, Ito does not specifically teach creating a storage folder for storing documents to said ASP.

However, official Notice is taken that storing data in various storage folder created by a user is well known in the art. For example, an Internet Service Provider (ISP) may offer each subscriber certain storage space for storing personal web pages, wherein a file manager is available for creating various subfolders for storing designated document types.

Since Ito's image storage server needs to handle different subscribers' data and each subscriber may transfer different types of data or image into the server, it is obvious to one of ordinary skill in the art to have used the well known file manager to create different folders for different subscribers, and various subfolders under each subscriber's folder to record different type of document information, because this is a nominal approach for organizing large volume of data.

14. As to claim 18, Ito does not specifically teach using an Internet facsimile machine for transmitting the document information as an attached e-mail, whereby an email address is provided for such purpose.



However, official Notice is taken that using Internet facsimile machine for transmitting the document information as an attached e-mail is well known in the art. Since Ito's teaches that the document information (which is essentially in image format) can be transmitted to the image storage server via email, it is obvious that the document information have to be formed as an attached image file to an email and may be forwarded via the Internet facsimile machine, because it is convenient to make use of the popular protocol for transmitting attached image file in the Internet environment.

15. As to claims 25-28, 37 and 39, since the features of these claims can also be found in claims 1, 6-9, 18, 20 and 38, they are rejected for the same reasons set forth in the rejection of claims 1, 6-9, 18, 20 and 38 above.

16. Claims 10-13 and 29-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ootsuka [U.S. PGPub 20040143456];

Shirakawa [U.S. PGPub 20010051990];

DiRienzo [U.S. Pat. No. 6199115];

Kulakowski [U.S. PGPub 20040100648]; and

Art Unit: 2154

Shiigi [U.S. Pat. No. 6564249].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (703)305-4875. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(703)746-5516 for status inquires draft communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Wen-Tai Lin

July 27, 2004

*Wen-Tai Lin*  
7/27/04